



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/681,804

06/07/2001

James Terry Dollens

5344

23552

7590

11/17/2005

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

LAFORGIA, CHRISTIAN A

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,804

Applicant(s)

DOLLENS, JAMES TERRY

Examiner

Christian La Forgia

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-57 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 29-57 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The amendment of 22 August 2005 has been noted and made of record.
2. Claims 29-57 have been presented for examination.

Response to Arguments

3. Applicant's arguments filed 22 August 2005, with respect to claims 36-51, have been fully considered but they are not persuasive.

4. In response to the applicant's argument that the cited reference fails to disclose isolating unauthorized objects from the computer system, the Examiner disagrees. As discussed on page 10 of the amendment filed on 22 August 2005, the Applicant recites the section cited by the Examiner, which in summation includes detecting unauthorized, potentially malicious, changes to a file. One of ordinary skill in the art clearly recognizes that one would isolate unauthorized data from data that has been authorized and secured since it has been well known in the art since at least September 1998, as illustrated by U.S. Patent No. 5,802,275 to Blonder, hereinafter Blonder. As discussed in Blonder, one would be motivated to isolate objects that have been altered to prevent the dissemination of viruses amongst the remaining system objects.

5. If Applicant challenges a factual assertion as not properly based upon common knowledge, the Examiner must support the adequate evidence. Upon the next action, the Examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *In re Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697. If the Examiner adds a reference in the next Office action after applicant's rebuttal, and the newly cited reference is added only as directly corresponding evidence to support the prior

Art Unit: 2131

common knowledge finding, and it does not result in a new issue or constitute a new grounds of rejection, the Office Action may be made final.

6. Applicant's arguments with respect to claims 29-34 and 52-57 have been considered but are moot in view of the new ground(s) of rejection.

7. See further rejections that follow.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of ***ying out his invention.

9. Claims 29-35, and 52-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. An amendment to the claims or addition of a new claim must be supported by the description of the invention in the application as filed. See MPEP § 2163.03, see also *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989). The limitations at issue are specifically:

inserting a first identifier into a steganographic zone of the object wherein the first identifier and the stenographic zone of the object are formed by the computer system and the first identifier prevents the execution of the executable object; and

comparing the first identifier in the steganographic zone to a second identifier each time the object is selected for execution, wherein an executable version of the object is created if the first identifier matches the second identifier.

Art Unit: 2131

The description of the invention merely states that the identifiers are compared and if the identifiers match, the object is executed. There is no disclosure of the identifiers preventing execution of the object, merely that the object is treated as a “non-self object” and the “administrator is notified” (page 13). There is also no disclosure of creating a separate executable version of the object the description merely states that the object is authenticated for execution if the identifiers match (page 13).

10. Therefore, the amendments to the claims lack a written description in the specification.

Claim Rejections

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 29, 31, 32, 52, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,612,044 to Raab et al., hereinafter Raab in view of U.S. Patent Application Publication No. 2001/0037450 to Metlitski et al., hereinafter Metlitski.

13. As per claims 29 and 52, Raab discloses a method for authorizing execution of an object on a computer system comprising:

(a) selecting an executable object on the computer system (column 11, lines 52-65, i.e. executable programs);

(b) inserting a first identifier into a steganographic zone of the object, wherein the first identifier and the stenographic zone of the object are formed by the computer system and the first identifier prevents execution of the executable object (column 11, line 52 to column 12, line 7, i.e. insert an executable program site identifier which prevents the program from being executed at multiple sites); and

(c) comparing the first identifier in the steganographic zone to a second identifier each time the object is selected for execution (column 11, line 52 to column 12, line 7, i.e. compare the identifiers).

14. Raab does not teach wherein an executable version of the object is created if the first identifier matches the second identifier.

15. Metlitski discloses wherein an executable version of the object is created to be executed (paragraph [0204]).

16. Both Raab and Metlitski are related in the field of process protection.

17. Paragraphs [0203]-[0208] disclose techniques for how to create a copy of an object for execution.

18. It would have been obvious to one of ordinary skill in the art at the time the invention was made to create an executable version of the object, since Metlitski states at paragraph [0002] that such a modification provide security and authentication of an executable program in an open architecture computer system.

19. Regarding claims 31, 38, and 46, Raab discloses wherein the second identifier is stored on the system (column 11, line 52 to column 12, line 7, i.e. second identifier stored on coordinate measurement system).

20. Regarding claims 32, 39, 47, and 54, Raab discloses wherein the second identifier is stored on an external data storage structure (column 11, line 52 to column 12, line 7, i.e. second identifier stored on coordinate measurement system).

21. Claims 30, 33-35, 52 -54, 56, and 57 rejected under 35 U.S.C. 103(a) as being unpatentable over Raab in view of Metlitski as applied above, and further in view of U.S. Patent No. 6,788,800 to Carr et al., hereinafter Carr.

22. Regarding claims 30, 37, 45, and 53, Raab and Metlitski do not disclose wherein the identifiers comprise a sequence of fields for creating a unique copy of the object and an ownership token between the object and the system.

23. Carr teaches wherein the identifiers comprise a sequence of fields for creating a unique copy of the object and an ownership token between the object and the system (column 2, lines 45-65, column 6, lines 28-46).

24. It would have been obvious to ordinary skill in the art at the time the invention was made to have the identifiers comprise a sequence of fields for creating a unique copy of the object and an ownership token between the object and the system, since Carr states at column 1, lines 11-15 that such a modification would aid in authenticating data using the embedded security data.

25. Regarding claims 33, 41, and 49, Raab and Metlitski do not disclose wherein the first identifier is extracted from the steganographic zone of the object.

26. Carr teaches wherein the first identifier is extracted from the steganographic zone of the object (column 4, lines 47-59).

Art Unit: 2131

27. It would have been obvious to ordinary skill in the art at the time the invention was made to have wherein the first identifier is extracted from the steganographic zone of the object, since Carr states at column 1, lines 11-15 that such a modification would aid in authenticating data using the embedded security data.

28. With regards to claims 34, 42, 50, and 56, Raab and Metlitski do not disclose wherein the external data storage device comprises data for extracting the first identifier.

29. Carr teaches wherein the external data storage device comprises data for extracting the first identifier (column 4, lines 37-59).

30. It would have been obvious to ordinary skill in the art at the time the invention was made to extract the first identifier, since Carr states at column 1, lines 11-15 that such a modification would aid in authenticating data using the embedded security data.

31. Regarding claims 35, 43, 51, and 57, Raab and Metlitski do not disclose wherein the system identifier is encrypted.

32. Carr discloses wherein the system identifier is encrypted (column 2, lines 56-65).

It would have been obvious to ordinary skill in the art at the time the invention was made to encrypt the identifier, since Carr states at column 1, lines 11-15 that such a modification would aid in authenticating data using the embedded security data.

33. Claims 36-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr in view of U.S. Patent No. 5,919,257 to Trostle, hereinafter Trostle.

34. As per claims 36 and 44, Carr discloses a method for identifying unauthorized objects on a computer system comprising:

(a) authorizing objects of the computer system by embedding a system identifier into the authorized objects (column 2, line 45 to column 4, line 28);

(b) determining the presence of the system identifier in objects of the computer, wherein objects that are not embedded with the system identifier are unauthorized (column 4, line 30 to column 5, line 46).

35. Carr does not teach isolating unauthorized objects from the computer system.

36. Trostle discloses isolating unauthorized objects from the computer system (column 7, lines 28-42).

37. It would have been obvious to one of ordinary skill in the art at the time the invention was made to isolate the unauthorized objects from the computer system, since Trostle states at column 7, lines 28-42 that such a modification would isolate objects that have unauthorized changes, which may be potentially malicious code.

38. Regarding claims 40, 48, and 55, Carr discloses wherein the system identifier is embedded in a steganographic zone of the object (column 1, lines 38-49, i.e. "steganographically embeds security data into the data").

Conclusion

39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

40. The following patents are cited to further show the state of the art with respect to comparing identifiers for authorization, such as:

United States Patent No. 6,807,632 to Carpentier et al., which is cited to show comparing identifiers for authorization of files.

United States Patent No. 6,134,597 to Rieth et al., which is cited to show CRC hash compressed server object identifiers.

United States Patent No. 5,978,791 to Farber et al., which is cited to show a data processing system using substantially unique identifiers to identify data items.

United States Patent No. 6,345,360 to Kamada et al., which is cited to show managing files with alteration preventing/detecting functions.

United States Patent No. 5,050,212 to Dyson, which is cited to show verifying the integrity of a file stored separately from a computer.

41. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

42. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2131

43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792.

The examiner can normally be reached on Monday thru Thursday 7-5.

44. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

45. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christian LaForgia
Patent Examiner
Art Unit 2131

clf

CLF
Primary Examiner
Art 2131
11/14/05